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Applicant : Claus Frohberg
Serial No. : 09/744,852
Filed : May 31, 2001
For : NUCLEIC ACID MOLECULE CODING FOR
BETA-AMYLASE, PLANTS SYNTHESIZING
A MODIFIED STARCH, METHOD OF PODUCTION
AND APPLICATIONS
Examiner: : R. Kallis
Group Art Unit : 1638

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Marilyn M. Brogan, Reg. No. 31,223

Name of Applicant, Assignee or Registered Representative

Marilyn M. Brogan
Signature

November 4, 2002

Date of Signature

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**RESPONSE TO OFFICE ACTION WITH REQUEST FOR
WITHDRAWAL OF RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed on October 3, 2002, setting a one month
term for reply. A response filed on November 4, 2002 is considered timely, as November 3 was
a Sunday.

The Office Action required election from among:

Group I: Claims 1-21, 24 and 25, drawn to a nucleic acid molecule and method of
using; and

Group II: Claims 22 and 23, drawn to a starch.

Group I is elected with traverse for further examination in this application. Applicants retain the right to file divisional applications to non-elected subject matter. Reconsideration and withdrawal of the restriction requirement are requested in view of the remarks herein.

Example 1 of Annex B Part 2 of the PCT Administrative Instructions (Appendix AI of the MPEP) provides, in part:

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Unity exists between claims 1 and 2. The special technical feature common to the claims is substance X.

In this case, the starch of the Group II claims ("substance X"), and the process ("method of manufacturing substance X") of claim 21, included in Group I, have unity of invention according to the PCT Administrative Instructions and should be searched and examined in the same application. Under PCT Rule 13.2, all claims must share the same special technical feature. The technical feature uniting the Group I and Group II claims is that they all relate to modified starch.

The Office Action further required election of a species with respect to part b of claim 2. Applicants elect glucosidases with traverse. It is understood that the Examiner can broaden the search to include other species, e.g., upon determining that a species is allowable, or when there is a relationship among the species and/or number of species is not too great.

In this case, there is clearly a relationship among the species. All of the molecules listed in claim 2, part b, are enzymes that are involved in starch metabolism. This is disclosed, for example, on page 3, line 15, of the specification. The combination of a nucleic acid molecule encoding a β -amylase with a nucleotide sequence encoding an enzyme that effects starch metabolism is an important inventive concept of the instant application. The relationship between the species dictates that they be searched and examined in the same application.

The result of the present restriction requirement is inefficiency and unnecessary expenditures by both the Applicants and the PTO and extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action. These factors mitigate against the restriction as it currently stands.

Hence, it is evident that there is unity of invention in the pending claims, and in view of the foregoing, reconsideration and withdrawal of the requirement for restriction and favorable consideration of the claims on the merits are respectfully requested.

Respectfully submitted,

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